

## **REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-22 are pending in this application. Claim 1 has been amended to better clarify the scope of the invention by introducing two separate formulae (IIIA and IIIB); support for this amendment can be found throughout the specification, e.g. in original claim 6 defines  $R^3$  to be an unsaturated  $C_1-C_5$  alkyl - however, the valency was incorrectly depicted for the situation where  $R^3$  was  $=CH_2$  in formula (III), which has now been corrected by separated formula (III) into formulae (IIIA) and (IIIB). No new matter has been added. The applicants reserve the right to further prosecuted the scope of the originally filed claims in a continuation application.

A corrected IDS is being filed with this application which again lists U.S. Patent 5,532,289 for consideration.<sup>1</sup>

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE 35 U.S.C. 112. 2<sup>nd</sup> PARAGRAH REJECTION HAS BEEN OVERCOME**

Claims 5-7, 9, 13, 14, 16, 18 and 19 were rejected as allegedly being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as his invention for the reasons which are addressed below:

- (1) The term "hydrocarbyl esters" has been deleted from claims 5 and 6 which renders this rejection moot.

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<sup>1</sup> In order to advance prosecution, an additional IDS has been submitted with this response. However, there is no basis under 37 CFR 1.97 for the refusal to consider U.S. Patent 5,532,289 and this refusal is not consistent with the tenets of the PTO's policy of compact prosecution and customer service goals. The reference was clearly identified as a U.S. Patent and a copy of the reference was provided even though applicants were not required to do so, i.e. the typographical error in the Form-1449 did not prevent proper understanding of what was intended by the applicants just as the Examiner's typographical error in paragraph 2. of the Office Action did not prevent applicants

- (2) Claims 9, 13 and 14 have been amended to delete the term “means” from the claim language as this is surplusage which does not further define the claimed invention. The intended scope of the claim is unchanged while enhancing the clarity of the claims.
- (3) Claims 16 and 17 have been amended to establish antecedent basis for the term “acid”
- (4) Claim 15 has been amended to refer to the formation of a “polymer”, thereby establishing antecedent basis for term in claim 18.

### **III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

Claims 1-22 were rejected as allegedly being obvious over Mancini et al. (U.S. Patent 4,056,496) in view of Mitra et al. (U.S. Patent 5,212,015). The applicants request reconsideration of this rejection as the combination of Mancini<sup>2</sup> and Mitra do not teach all the elements of the applicants' claimed invention.

The rejection of the claims asserts that Mancini refers to a deketalization of a compound substantially identical to the chemical of Formula II as claimed with a strong acid (referring to col. 3, line 32-48). However, there is no such disclosure of deketalization from Mancini. In fact, there is no disclosure anywhere in Mancini as how the compound represented by col. 3, line 35 is obtained. Such that it could be speculated as to how the compound was obtained, one of ordinary skill in the art would view this as being the equilibration product of the epoxidized alkyl acrylates referred to by Mancini (see e.g. col. 4, lines 59-65 - compare this compound with the compound of formula (II) in applicants' claim 1).

In addition, the applicants claimed invention is directed toward a process of preparing a crosslinker AND a polymerizable monomer for formula (I). Mancini at best refers to the compound of col. 3, line 35 only in the context as being a co-monomer for the formation of a polymer, i.e. there is no disclosure a crossliner and polymerizable monomer being formed.

Mancini also does not teach the use of an immobilized acid (“hydrolyzed with dilute aqueous solution of strong mineral acid” - see col. 3, lines 44-46). While Mitra does teach the use of an immobilized acid, there is no reason to selectively pick this particular element from Mitra to combine with the teachings of Mancini. “It is well

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understanding of why the reference was not considered. As such, the applicants request a refund of the fee set forth in 37 CFR 1.17(p) as U.S. Patent 5,532,289 should have been considered with the originally filed IDS.

<sup>2</sup> The applicants note that the Mancini reference was categorized as an “A” reference in the International Search Report for corresponding PCT application (WO 00/63150), i.e. a document defining the general state of the art which not considered to be of particular relevance.

known that ‘virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)(citations omitted).

Mitra is clearly directed toward a process of forming monocarbamate diols and polymers thereof whereas Mancini is directed toward a process of forming polymers and hydrogels of polymers. In addition, while Mitra refers to a ketal precursor, Mancini makes no such reference in their disclosure. One of ordinary skill in the art have the Mitra and Mancini references before them but without benefit of the applicants’ claims would not seek to make the modifications suggested by the Examiner as there is no direction or guidance from within the reference to make such a modification. While the motivation to combine can come from within the art itself, the Mitra and Mancini inventions are too remote to render obvious such a precise combination of elements from the respective references.

Therefore, since neither reference teaches a deketalization process for the diol as claimed by the applicants, nor teaches a combination of crosslinker and monomer of formula (I), nor suggests the use of an immobilized acid as claimed in the applicants process, the applicants’ claimed invention is not *prima facie* obvious over Mancini and Mitra.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
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